



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Application Serial No. 09/381,771

Filed: October 26, 1999

Art Unit: 3611

Examiner: Joanne Silbermann

**FIGURATIVE PRINT ON A PLANE PRINT CARRIER
AND USE OF SUCH FIGURATIVE PRINT**

Ex parte: Erik Brogaard Thomsen

BRIEF FOR THE APPELLANT

Day Pitney LLP
Attorneys for the Appellant

06/12/2009 HDESTA1 00000051 09381771

DP Ref.: 2424-19

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I. REAL PARTY IN INTEREST

The real party in interest is LogoPaint.

II. RELATED APPEALS AND INTERFERENCES

The Board rendered an opinion on June 21, 2004. A copy of the opinion is included herewith under Section X.

III. STATUS OF CLAIMS

Claims 27-36 are rejected and are being appealed. Claims 1-26 are canceled.

IV. STATUS OF AMENDMENTS

No response was filed to the final Office Action of December 4, 2008. A Notice of Appeal was dated April 6, 2009, with an apparent Office filing date of April 9, 2009.

V. SUMMARY OF CLAIMED SUBJECT MATTER

An aspect of the claimed invention (Claim 27) relates to a method of: providing an image to be viewed, whereby said image has first, second and third orthogonal directions (page 2, line 8, also see three dimensional rendering of Figure 1); reconfiguring said image to a planar image whereby said first orthogonal direction and said second orthogonal direction form an angle of 90 degrees minus a first predetermined non-zero angle (Page 4A, lines 6-10 'noting that directions B and D are indicated as being parallel'; Figure 3, directions A and B are at an angle of 90 minus α degrees) and whereby said second orthogonal direction and said third orthogonal direction form an angle of 90 degrees plus a second predetermined non-zero angle (Figure 3, directions B and C are at an angle of 90 plus β degrees¹); placing said reconfigured planar image at a given angle with respect to a viewer whereby said image appears to the viewer to protrude from said reconfigured planar image and have said first, second and third orthogonal directions (page 1A, line 29 – page 2, line 12), wherein the first and second orthogonal directions form a plane different from the plane of said planar image (page 1A, line 29 – page 2, line 12); and wherein said image comprises a primary figurative element and a secondary figurative element, wherein said secondary figurative element depicts a third dimension of said image (page 2, lines 14 and 15; page 3, lines 19 and 20, referring to Figures 1 and 2).

¹ This can also be obtained by adding the $\alpha+\beta$ (the angle between the first and third dimensions) from the paragraph bridging pages 4 and 4A to the $90-\alpha$ (the angle between the first and second dimensions) from the first full paragraph of page 4A, thereby obtaining the angle $90 + \beta$, the angle between the second and third dimensions, consistent with Figure 3.

VI. GROUND OF REJECTION TO BE REVIEWED UPON APPEAL

Are Claims 27-36 patentable under 35 U.S.C. §103(a) over the Brown reference (WO 93/04559) in view of the Fontworks, Sanity Font reference?

VII. ARGUMENTS

Are Claims 27-36 patentable under 35 U.S.C. §103(a) over the Brown reference (WO 93/04559) in view of the Fontworks, Sanity Font reference?

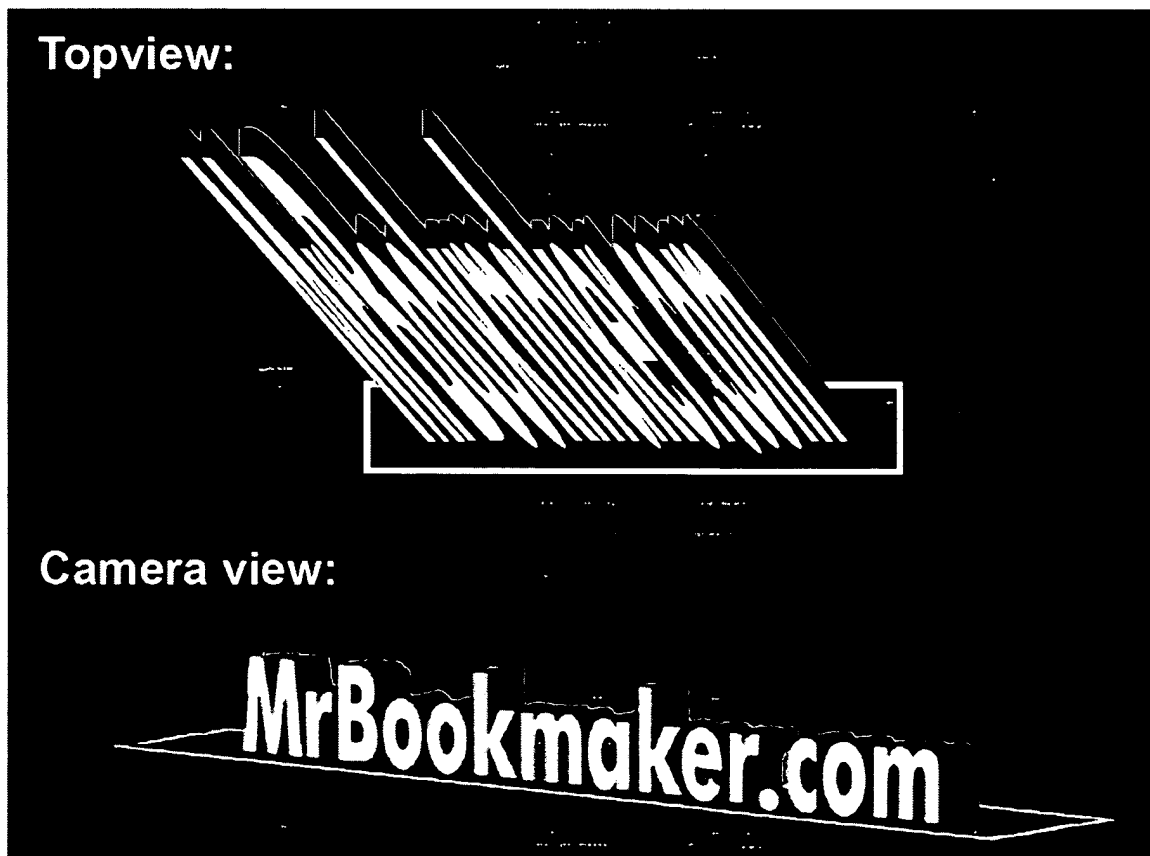
A primary object of the presently claimed invention is to provide an image of an advertisement (an advertisement print) which, when viewed from an oblique direction, appears to integrate with the surroundings, in that the elements of the image appear to be the same as would elements of a real physical object and the elements of the image are positioned in the same way as elements of a real element would be positioned, such as resting on an existing surface and not contradicting any physical laws. This integration is achieved by providing a “secondary figurative element” which gives the appearance of being perpendicular to a primary advertisement image when viewed from the oblique direction. By providing the appropriate angles between the lines of the third dimension image (the “secondary figurative element”) and the lines forming the primary advertising image (i.e., the first and second dimensions of the image of the advertisement), the desired effect is achieved. As a result, the image of the advertisement is perceived as having three dimensions, and therefore is more easily integrated,

perceptually, into the surroundings. It is thus possible to present a three-dimensional image of the advertisement without visually confusing the viewer.

In greater detail, the presently claimed invention relates to an advertisement comprising a print comprising primary and secondary figurative elements. The elements have been made in such a way that when viewed from an oblique angle (Camera view), the primary elements transform into a first plane different from the advertising plane, and the secondary elements transform into a second plane perpendicular to said first plane.

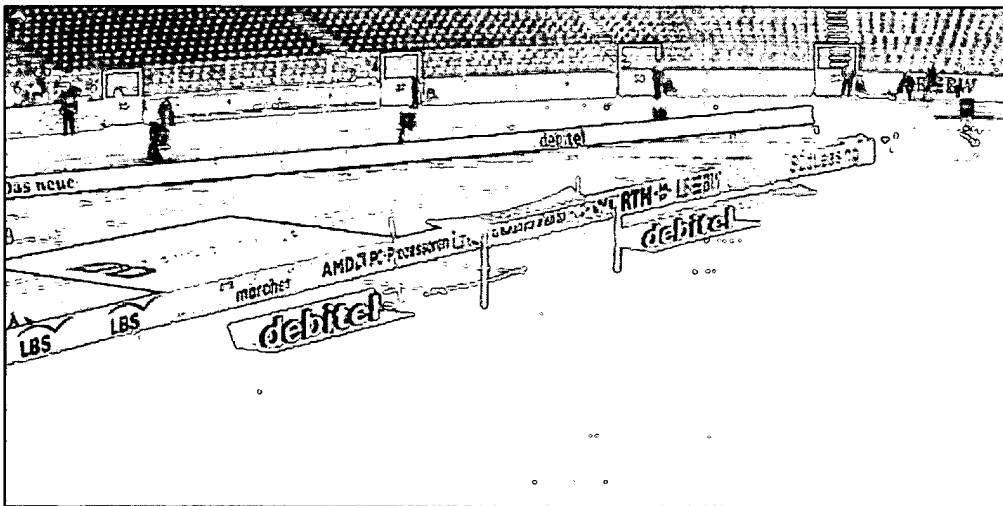
See below figure for the different angles of view of the same print

(All images included herein were presented to the Examiner in the Request for Reconsideration dated August 6, 2008)

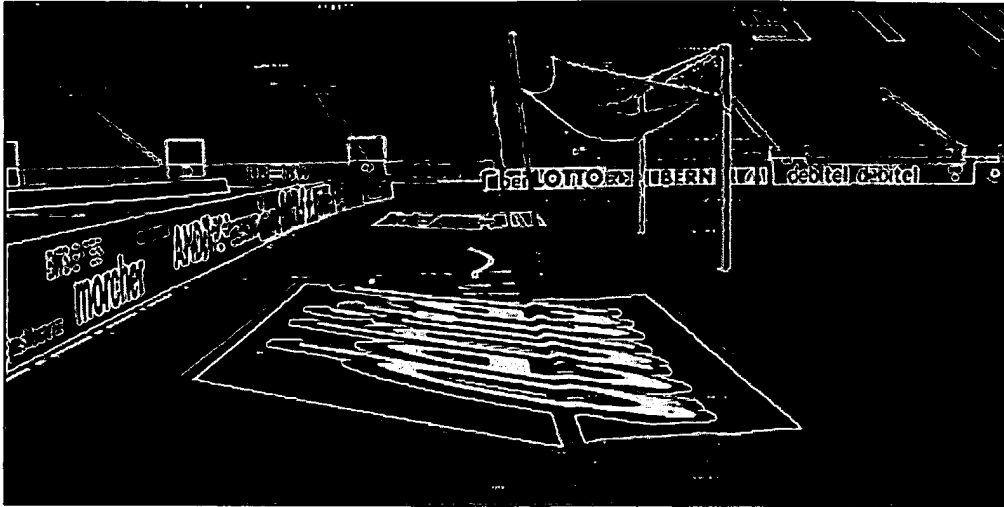


As mentioned in the patent application, the problem to be solved is to make an advertisement print which, when being viewed from an oblique direction, integrates with the surroundings. This is obtained with an advertisement print as defined in claim 1. The perfect integration is obtained by the third dimension from the secondary element, which appears to be perpendicular to the plane of advertisement when seen in an oblique direction. An advantage with this perfect integration is that the advertisement is integrated with the surroundings, and it is possible to use the advertisement and obtain the three-dimensional effect without disturbing the viewer and the viewer's visual experience of the event.

In the below figures similar prints as shown above are positioned on a soccer field.



This picture shows the print according to the presently claimed invention being viewed from an oblique viewpoint; the white front of the letters being the first dimension formed by the primary figurative element and the black depth of the letters together with the green support are the second dimension formed by the secondary figurative element.



This picture shows the print according to the presently claimed invention and, as illustrated above, being viewed from another viewpoint; the white front of the letters being the primary figurative element and the black and green part being the secondary figurative element.

The attention of the Board is respectfully drawn to the first picture wherein the second dimension comprising the depth and the green support is made perpendicular to the lines of the surroundings in the field.

This is quite different from the Brown reference wherein no secondary figurative element is disclosed and only a two dimensional image is achieved. More specifically, the Brown reference refers to an image and the inverse perspective transformation of the image without destroying the visual experience of the user/reader. Nothing in the Brown reference discloses or suggests that the image is three dimensional or how this image could be transformed to obtain the three dimensional effect.

In other words, the Brown reference describes, in overall terms, how an image can be depicted in an inverse perspective form on a playing field, whereby, when said image is viewed from a video camera, it appears to be in a plane having an angle to the actual plane whereon the image has been depicted. The Brown reference does not describe how to add further elements to

the depicted image in such a way that when said image is viewed from a video camera, it appears to have both a first surface plane in a first dimension and a second depth plane in a second dimension.

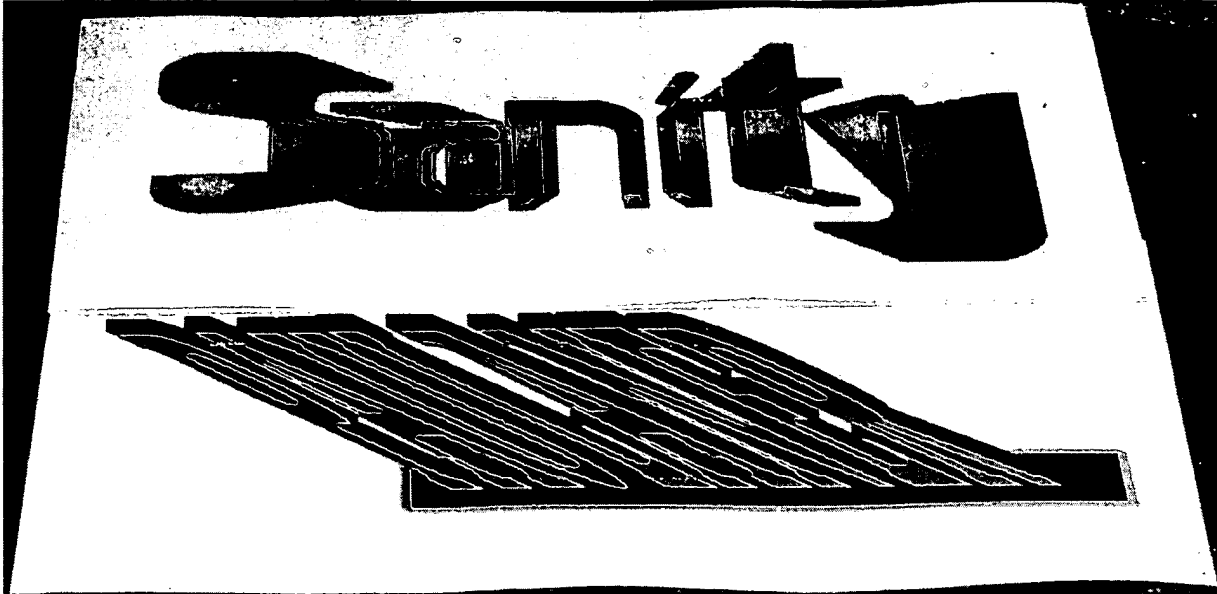
Further, it is respectfully submitted that this deficiency is not remedied by the Fontworks, Sanity Font reference as one would not be taught how to define the angles with respect to the first and second dimensions such that a third dimension is obtained and appears to be perpendicular to the plane of advertisement when the print carrier is seen in the third direction. Moreover, such a combination is even more unlikely to be suggested as the Fontworks, Sanity Font reference is merely a perspective rendition, much like a painting on a museum wall, which achieves its effect through an extremely wide viewing angle. This is quite different from the presently claimed invention, wherein the three-dimensional effect, as well as the effect of the secondary figurative element, is achieved when viewed from the given oblique direction.

Furthermore, the Fontworks, Sanity font reference illustrates the word 'sanity' where a special font has been used. This font has a front which has been added to achieve an artistic effect. When looking at the letters from an oblique angle, the front of the letters does not appear in a plane different from the print plane. Similarly, the second element, being the artistic effect, does not appear in a plane perpendicularly to the plane of the letter front.

In the Fontworks, Sanity font reference, typefaces are shown having a three-dimensional appearance when viewed in a direction perpendicular to the print carrier. The person skilled in the art seeking to improve the apparatus described in the Brown reference, by looking at the Fontworks reference, would not know how to add a secondary figurative element depicting a third dimension, including how to define the angles to the first and second dimension such that a

third dimension is obtained that appears to be perpendicular to the plane of advertisement when the print carrier is seen in the oblique direction.

Oblique angle (non-matching):



Oblique Angle (Matching):



It is therefore respectfully submitted that all of the presently pending claims are patentable over the Brown reference and the Fontworks, Sanity Font reference.

The Board is respectfully requested to find all of the presently pending claims to be allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Ronald E. Brown", with a stylized flourish at the end.

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VIII. CLAIMS APPENDIX

27. A method of:

providing an image to be viewed, whereby said image has first, second and third orthogonal directions;

reconfiguring said image to a planar image whereby said first orthogonal direction and said second orthogonal direction form an angle of 90 degrees minus a first predetermined non-zero angle and whereby said second orthogonal direction and said third orthogonal direction form an angle of 90 degrees plus a second predetermined non-zero angle;

placing said reconfigured planar image at a given angle with respect to a viewer whereby said image appears to the viewer to protrude from said reconfigured planar image and have said first, second and third orthogonal directions, wherein the first and second orthogonal directions form a plane different from the plane of said planar image; and

wherein said image comprises a primary figurative element and a secondary figurative element, wherein said secondary figurative element depicts a third dimension of said image.

28. The method of Claim 27 wherein said secondary figurative element is chosen from the group consisting of a shadow and a relief.

29. The method of Claim 27 wherein said image further comprises a tertiary element which provides an element chosen from the group consisting of a foreground, background and frame.

30. The method of Claim 29 wherein said first and second predetermined angles are less than ninety degrees.

31. The method of Claim 27, wherein the planar image is made of a curable, liquid printing ink, that the ink is applied to a planar print carrier in a liquid state, and that the ink is cured on the planar print carrier.

32. The method of Claim 27, wherein the planar image is made by printing on a carrying medium and that the carrying medium is laid on a planar print carrier.

33. The method of Claim 32, wherein the planar print carrier is a ground surface.

34. The method of Claim 32, wherein the planar print carrier is a vertical surface.

35. The method of Claim 27 wherein said reconfigured planar image is horizontal and placing said reconfigured planar image at a given angle with respect to a viewer whereby said image appears to the viewer to protrude vertically from said reconfigured planar image.

36. The method of Claim 27 wherein placing said reconfigured planar image at a given angle with respect to a viewer whereby said image appears to the viewer to protrude perpendicularly from said reconfigured planar image.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

See attached decision.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

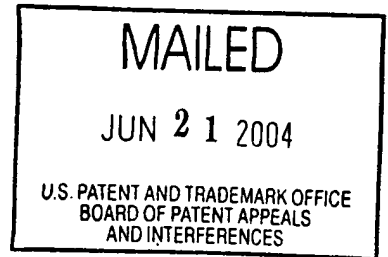


UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIK BROGAARD THOMSEN

Appeal No. 2004-1306
Application No. 09/381,771

ON BRIEF



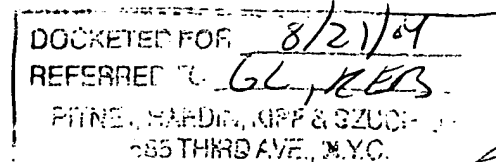
Before WARREN, OWENS, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 9 through 17 (final Office action mailed Apr. 9, 2002, paper 10), which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to "[a]n advertisement print being printed on a plane print carrier." Further details



EXPIRATION DATE

of this appealed subject matter are recited in representative claim 9 reproduced below:

9. An advertisement print being printed on a plane print carrier, and which print is plane and lies in the same plane as the print carrier and comprises a primary figurative element depicting an advertisement in a first dimension and a second dimension, which primary figurative element when seen in a direction perpendicular to the plane of the print carrier constitutes an angle $\alpha+90^\circ$ between the first dimension and the second dimension, and which primary figurative element when seen in a given oblique direction between a viewer and the print shows a first dimension and the second dimension as forming a plane of advertisement, which plane of advertisement is directed obliquely outwards of the plane of the print carrier, wherein the advertisement print comprises a secondary figurative element depicting the advertisement in a third dimension, that the secondary figurative element when seen in a direction perpendicular to the plane print carrier constitutes an angle $\alpha+\beta$ between the first dimension and the third dimension and an angle $\beta+90^\circ$ between the first [sic] dimension and the third dimension and which secondary figurative element when seen in the given oblique direction between the viewer and the print shows the third dimension as directed perpendicular to the plane of advertisement being formed by the first and the second dimension and that the angles α , β are different from 0° .

17. An advertisement print according to claim 9, wherein the plane print carrier is a vertical surface.

The examiner relies on the following prior art references as evidence of unpatentability:

Rusin

5,941,002

Aug. 24, 1999
(filed Apr. 02, 1997)

Blue Knot Software, B/W Fontworks, at <http://www.revealed.net/bwsoft/fonts.html> (published Jun. 07, 1997) (hereinafter "Fontworks").¹

Claims 9 through 17 on appeal stand rejected under 35 U.S.C. § 101 as lacking "patentable utility." (Examiner's answer mailed Mar. 11, 2003, paper 15, page 3.) Also, claims 9 through 15 on appeal stand rejected under 35 U.S.C. § 102(b) as anticipated by Fontworks.² (Id. at pages 4-5.) Further, claims 16 and 17 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fontworks in view of Rusin. (Id. at page 5.)

We reverse the 35 U.S.C. § 101 rejection but affirm the rejections under 35 U.S.C. §§ 102 and 103(a) for the reasons well stated in the answer.³

35 U.S.C. § 101: Claims 9-17

The examiner's position is that "the invention simply constitutes an abstract idea, text on a surface and as such does

¹ See http://web.archive.org/web/*/http://home.revealed.net/bwsoft/fonts.html, copy attached.

² Although the examiner indicates that Fontworks is available as prior art under 35 U.S.C. § 102(b), we note that the reference is actually available as prior art under 35 U.S.C. § 102(a).

³ The appellant submits that the appealed claims stand or fall together for each ground of rejection. (Appeal brief filed Dec. 16, 2002, paper 12, p. 4.) Accordingly, for the §102(b) rejection, we select and confine our discussion to claim 9. For the §103(a) rejection, we select and confine our discussion to claim 17. 37 CFR § 1.192(c)(7)(2002) (effective Apr. 21, 1995).

not present subject matter for which a utility patent may be obtained." (Answer, page 3.) In support of this position, the examiner relies on State Street Bank & Trust Co. v. Signature Financial Corp., Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600-1601 (Fed. Cir. 1998).

We cannot agree with the examiner on this issue. 35 U.S.C. § 101 extends to "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980); see also Diamond v. Diehr, 450 U.S. 175, 182 (1981).

In this case, the appealed claims are directed to an advertisement print having the specified figurative elements thereon for the purpose of imparting a certain visual effect to an observer viewing the advertisement print from a certain perspective. (Specification, "Background of the Invention.") Thus, the invention recited in the appealed claims involves more than merely an abstract idea that does not produce "a useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1600-1601.

Accordingly, we cannot uphold the examiner's rejection on this ground.

35 U.S.C. § 102: Claims 9-15

To aid us in determining whether the examiner applied the prior art correctly against the appealed claims, we must first

consider the scope and meaning of certain terms that appear in representative claim 9. Gechter v. Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). It is well settled that, in proceedings before the United States Patent and Trademark Office (PTO), claims in an application are to be given their broadest reasonable interpretation, taking into account the written description found in the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow."); In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984) ("The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claim to obtain protection commensurate with his actual contribution to the art.'") (quoting In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)).

Appealed claim 9 recites the terms "advertisement," "primary figurative element," and "secondary figurative element." Neither the claim nor the specification places any limitation on the actual content of the advertisement or the

figurative elements. Under these circumstances, we determine that one skilled in the relevant art would understand appealed claim 9 to encompass any pair of figurative elements satisfying the recited characteristics with no limitation whatsoever as to textual content. Also, the angles recited in appealed claim 9 do not specify any reference object or portion of the figurative elements, and therefore one skilled in the relevant art would understand these angles to refer to any angle created by any portion of the figurative elements. Further, the term "comprises" indicates to one skilled in the relevant art that the advertisement print may contain other unrecited characters or figurative elements.⁴

We share the examiner's view that Fontworks describes each and every limitation of the invention as broadly recited in appealed claim 9. For example, the "y" in the "Sanity Font Family" or any of the characters of the "Glory Font Family" satisfies the requirements recited in appealed claim 9. Like the claimed invention, the characters shown in Fontworks include "a primary figurative element" (i.e., the face portion) which can be considered to depict "an advertisement" having the here

⁴ In claim drafting, the term "comprises" not only alerts potential infringers that the recited components are essential, but that other unrecited components may be included and still

recited characteristics. Furthermore, the characters include "a secondary figurative element" (i.e., the portions of a character behind the face portion) that may be considered to depict "an advertisement" having the here recited characteristics.

Accordingly, we determine that Fontworks describes each and every limitation of the invention recited in appealed claim 9.

The appellant argues that the print described in Fontworks does not satisfy the limitations of the claimed invention. (Appeal brief, pages 7-8.) The appellant's arguments, however, ignore or overlook the broad scope of appealed claim 9. As we stated above, the "y" of the "Sanity Font Family" or any of the characters of the "Glory Font Family" anticipates the invention recited in appealed claim 9. While the appellant relies on certain exhibits attached to the reply brief filed May 9, 2003 (paper 16) to establish a difference between the claimed invention and the prior art, the appellant fails to take into account the broad scope of appealed claim 9.

35 U.S.C. § 103(a): Claims 16 and 17

With respect to appealed claim 17, the appellant relies on the same arguments made against appealed claims 9-15. (Appeal

form a construct within the scope of the claim. See, e.g., In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981).

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Application No. 09/381,771

brief, pages 8-9.) Accordingly, we affirm this ground of rejection for the same reasons discussed above.

Summary

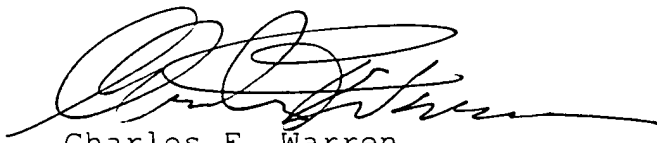
In summary, we reverse the examiner's 35 U.S.C. § 101 rejection of appealed claims 9 through 17 as lacking "patentable utility." We affirm, however, the examiner's 35 U.S.C. § 102 rejection of appealed claims 9 through 15 as anticipated by Fontworks and the 35 U.S.C. § 103(a) rejection of appealed claims 16 and 17 as unpatentable over Fontworks in view of Rusin.

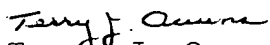
The decision of the examiner is therefore affirmed.

Appeal No. 2004-1306
Application No. 09/381,771

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


Charles F. Warren)
Administrative Patent Judge)
)
)
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Terry J. Owens)
Administrative Patent Judge)

BOARD OF PATENT

APPEALS AND

INTERFERENCES


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Administrative Patent Judge)

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Appeal No. 2004-1306
Application No. 09/381,771

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